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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,597	07/07/2005	Chantal Louis	261201US0PCT	5567
22850	7590	01/04/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.			NGUYEN, TAM M	
1940 DUKE STREET			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22314			1797	
			NOTIFICATION DATE	DELIVERY MODE
			01/04/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/511,597

Applicant(s)

LOUIS ET AL.

Examiner

Tam M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1/26/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “silica/alumina” in the last line of claim 1 renders the claim indefinite because it is unclear if the expression refers to “silica and alumina” or “silica or alumina”. Please recite the express as either --silica and alumina-- or --silica or alumina--. Appropriate correction is required.

The expression “(with respect to the total weight of the dry adsorbent solid)” in line 3 of claim 5 and in lines 3-4 of claim 7 renders the claims indefinite because it is unclear if the limitation inside the parentheses is part of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Funakoshi et al. (EP-056324 A1).

Funakoshi disclose a method of removing organic sulfur compounds from liquid oil. The oil is contacted with an oxidizing agent (e.g., hydrogen peroxide) in an oxidation zone followed by a stage of removing the oxidized sulfur compounds by adsorption on an adsorbent solid. Funakoshi also discloses that the adsorbent comprise 50 wt.% of alumina. (See abstract; page 3, lines 3-11, 47-52; page 7, line 7)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Funakoshi (EP-056324 A1).

The process of Funakoshi is as discussed above.

Funakoshi does not specifically disclose that the adsorbent has mesopores.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Funakoshi by utilizing an adsorbent having mesopores size because an adsorbent would have either micropores or mesopores and since the sulfur compounds, which are selective to adsorbed on the adsorbent, from the claimed process and the process of Funakoshi are the same. It is within the level of skill in the art to use an adsorbent having an appropriate pore size including mesopores.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funakoshi (EP-056324 A1) as applied to claim 1 above, and further in view of Chapados et al.

“Desulfurization by Selective Oxidation and Extraction of Sulfur-containing Compounds to Economically Achieve Ultra-low Proposed Diesel Fuel Sulfur Requirements” March 26-28-2000.

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The process of Funakoshi is as discussed above.

Funakoshi does not specifically disclose that the hydrocarbon feed comprises less than or equal to 80% by weight of aromatics.

Chapados discloses a hydrocarbon feedstock comprises less than 80 wt. % of aromatics as claimed. (See table 3)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Funakoshi by utilizing a feedstock comprising less than 80 wt. % of aromatics as taught by Chapados because of the similarities between the feed of Funakoshi and the feed of Chapados. It would be expected that the feedstock of Chapados would be effectively treated in the process of Chapados.

Since the similarities between the modified process of Funakoshi and the claimed process in terms of feedstock and oxidation process, it would be expected that the hydrocarbon mixture before entering to the adsorption zone would have a sulfur content as claimed.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Funakoshi et al. (EP-056324 A1) as applied to claim 1 above, and further in view of either Tsybulevskiy et al. (US 2002/009404 A1) or Frye et al. (U.S. 6,531,052).

The process of Funakoshi is as discussed above.

Funakoshi does not disclose that the adsorbent comprises at least one solid of crystalline structure in the amount of less than or equal to 40 % by weight.

Tsybulevskiy discloses an adsorbent for removal of sulfur compounds wherein the adsorbent comprises Y or X zeolite. (See abstract)

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Frye discloses a process for removal of sulfur species by utilizing an adsorbent comprising about 50-95 wt.% of alumina and about 5-50 wt. % of zeolite-Y. The adsorbent has a surface area greater than 200 m²/g. Frye further discloses that the adsorbent details in Fleming et al. (U.S. 4,762,537) which teaches that the adsorbent has a surface area greater of 450 m²/g. (See col. 2, lines 1-20)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Funakoshi by utilizing an adsorbent comprising alumina/silica and zeolite (which as taught by Tsybulevskiy) because it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Kerkhoven* 205 USPQ 1069 (CCPA 1980).

Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of Funakoshi et al. by utilizing an adsorbent comprising alumina and zeolite as taught by Frye because such adsorbent is effective to remove sulfur compounds from a hydrocarbon feed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M. Nguyen whose telephone number is (571) 272-1452. The examiner can normally be reached on Monday through Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tam M. Nguyen
Examiner
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TN